



3728

Attorney Docket No. 18176.01

Customer No. 37833

Confirmation No. 2572

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE *PATENT* APPLICATION OF:

APPLICANT : **ROBERT C. HOLCOMB**

APPL. NO. : **10827,299**

ART UNIT : **3728**

FILED : **APRIL 20, 2004**

EXAMINER: **PATTERSON, M.**

TITLED : **STOWABLE OVERSHOES HAVING TRACTION SOLES**

MAIL STOP AMENDMENT
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In the Office Action dated March 13, 2006, the Examiner required restriction under 35 U.S.C. § 121 prior to an examination on the merits of the above-identified application. The separate inventions identified by the Examiner are as follows:

- I. Claims 1-18, drawn to an overshoe.
- II. Claims 19-20, drawn to a method of making an overshoe.

The Examiner states that the inventions of Groups II and I are related as process of making and product made. In order to establish that the separate inventions of Groups I and II are distinct, the Examiner asserts that the product of Group I can be made by a process materially different from that of Group II.

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In compliance with the Examiner's restriction requirement, Applicants provisionally elect with traverse for further prosecution the invention defined by Claims 1-18 (designated as Group I).

Notwithstanding the propriety of the restriction requirement for examination purposes, Applicant contends that he should be entitled to a consideration of a reasonable number of related embodiments falling within the scope of a generic inventive concept. Moreover, it would appear that a search and examination of the entire application could be accomplished without a serious burden on the Examiner since the multiple embodiments identified of record would seemingly encompass a common field of search.

Therefore, it is respectfully requested that the Examiner withdraw the restriction requirement and issue an action on the merits of the claimed embodiments presently in the application. Alternatively, should the Examiner maintain the requirement, Applicant awaits a complete action on the merits of the elected subject matter.

Respectfully submitted,



Dolph H. Torrence
Registration No. 34,501
(703) 486-1000

DHT:RCL